Remarks

Applicants submit the following remarks in support of the patentability of the presently claimed invention. Further and favorable reconsideration is respectfully requested in view of these remarks.

Initially, claim 1 has been amended to return it to its originally filed scope, except that a proviso has been inserted to exclude the compound where R^2 and R^3 are simultaneously a hydrogen atom. Since as originally disclosed and claimed, each of R^2 and R^3 could be a hydrogen atom, excluding this embodiment does not constitute new matter, and thus amended claim 1 is clearly supported by the specification as filed.

Although claim 2 is an independent claim, it does not define formula (1). To correct this, claim 2 has been amended to incorporate formula (1) and the definitions for the variables as recited in claim 1.

Similar considerations apply to claim 3, which has therefore been amended to incorporate formulae (1), (2) and (3) from claims 1 and 2.

Claim 4 has been amended to insert the same proviso as set forth in amended claim 1.

Claim 10 refers to "formula (5) as defined in claim 1", but claim 1 does not define formula (5). Claim 10 has been amended for clarification to overcome this. A similar type of change has been made in claim 11.

Claims 10 and 11 have also been amended to insert the same proviso as set forth in amended claim 1.

The rejection of claim 3 under the second paragraph of 35 U.S.C. §112 is respectfully traversed.

The Examiner cites *Ex parte Tanksley*, 26 USPQ2d 1384 in support of this rejection. However, Applicants respectfully submit that this case law does not support the rejection. The word "obtainable" was not even at issue in the *Tanksley* decision. The rejection for indefiniteness in that decision involved nomenclature used by Applicants which could have been expressed in base sequence (at least partial) and/or function. The Court stated that since no whole genes are represented, this would require the designation of the function of the gene the clone represents. The issue of undue experimentation, or

enablement, dealt with in the *Tanksley* decision involved the lack of working examples for the claimed process and the complexity and unpredictability of the field of technology in question and the lack of guidance in the specification. The issue of undue experimentation, or enablement, is not even at issue in the present application, since the rejection is under the second paragraph of 35 U.S.C. §112, rather than the first paragraph.

Furthermore, Applicants note that the term "obtainable" has been used in the claims of numerous U.S. chemical patents, e.g. claims 26, 38 and 52 of USP 7,151,121; claim 7 of USP 7,150,905; claim 1 of USP 7,150,782; claims 8, 25 and 26 of USP 7,148,293, etc.

For these reasons, Applicants respectfully submit that the rejection of claim 3 under the second paragraph of 35 U.S.C. §112 should be withdrawn.

The rejection of claims 1-4, 10 and 11 under 35 U.S.C. §102(a) as being anticipated by Yamago et al. ("Organotellurium Compounds as Novel Initiators for Controlled/Living Radical Polymerizations. Synthesis of Functionalized Polystyrenes and End-Group Modifications", Journal of the American Chemical Society, 124 (12), 2874-2875, 2002.02.27), is respectfully traversed.

Applicants take the position that this reference, which was published on the Web February 27, 2002 (less than one year prior to the filing date of the PCT application on which the present U.S. application is based), is not available as prior art against the present invention. This reference names the two inventors named in the present application as coauthors, along with Kazunori Iida as a third coauthor. However, Kazunori Iida was not an actual inventor of any of the subject matter disclosed in the Yamago et al. reference, and in support of this, attention is directed to the attached Declaration of Kazunori Iida. For this reason alone, the rejection of the present claims based on this reference should be withdrawn.

The rejection of claims 1-4, 10 and 11 under 35 U.S.C. §102(b) as being anticipated by Kanda et al. ("Generation of allyl- and benzyllithiums from the corresponding halides by the aid of lithium-tellurium exchange reactions", Journal of Organometallic Chemistry, 473 (1994), 71-83), is respectfully traversed.

The Kanda et al. reference discloses, on pages 76 and 77, the compounds (2a) to (2o) which correspond to the compound of formula (1) of claim 1 of the present

application wherein R^1=n-Bu, R^2=R^3=H, and R^4=aryl or substituted aryl. These compounds have now been excluded from the present claims by the proviso inserted therein.

For these reasons, Applicants take the position that the presently claimed invention is clearly patentable over the applied references.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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